

Application No.: 10/576,326

REMARKS

By this amendment, the Abstract, Specification, and claims 1, 7, 12, and 13 are revised, claim 16 is canceled, and new claims 20 and 21 are added to place this application in immediate condition for allowance. Currently, claims 1-15, and 17-21 are before the Examiner for consideration on their merits.

First, the Abstract and Specification have been revised in accordance with the Examiner's request and the objections in this regard are now moot.

Second, the informalities in claims 7, 12, and 13 have been corrected. The language removed from claims 12 and 13 is presented as new claims 20 and 21, respectively.

Third, claim 1 is revised to overcome the prior art rejection by the inclusion of language that further defines the sides of the lens, with the wedge-shaped recesses on one side and a superposition of spherical and non-spherical segments of one or several Fresnel lenses on the other side. The change to claim 1 does not raise any issues of new matter since the added language of claim 1 is found in original claim 16.

Lastly, Applicant submits that claims 16 and 17 are not indefinite in the use of spherical and non-spherical segments of the one or more lenses. Applicant submits that this language is clear on its face, i.e., one side of the lens has at least two types of segments, one that is spherical and one that is not. One of skill in the art would readily understand this language and its use in claim 1, as amended, and claim 17 does not render these claims indefinite under 35 U.S.C. § 112, second paragraph. In light of this argument, the Examiner is requested to either withdraw the rejection or explain in more

detail why the use of the terms of "spherical" and "non-spherical" when identifying the segments of the lens cannot be understood.

Turning now to the rejection, the revision to claim 1 now alters the issue of obviousness and the rejection of the claims is only relevant as made against original claim 16.

In the rejection, the Examiner alleges that claim 16 is anticipated by United States Patent No. 5,712,721 to Large. The Examiner contends that the wedge shaped recesses are on one side of the lens 10. In addressing the limitation of the spherical and non-spherical segments, the Examiner states that the Fresnel lens 10 is "capable of containing spherical or non-spherical segments depending on the lens chosen", citing col. 2, lines 55-59. It appears from this statement that the Examiner is assuming that the claimed lens configuration is disclosed in Large.

Applicant submits that it is error for the Examiner to use the col. 2 disclosure to support a rejection based on 35 U.S.C. § 102(b). Large does not say anything about the combination of spherical and non-spherical segments on one side of the lens 10. Therefore, the Examiner can only support the allegation of anticipation based on an inference or inherency. However, this approach fails since there is nothing in Large to conclude that the claimed segments are somehow inherent or inferred in the teachings of Large. Therefore, the rejection of claim 1, as amended, based solely on Large is improper and must be withdrawn. Again, the col. 2 disclosure cannot serve as a basis to support an anticipation rejection since nothing is said regarding the side opposite the wedge shaped recess-containing side having the claimed features.

As importantly, claim 1 requires the combination of the wedge shaped recesses on one side of the lens and the claimed spherical and non-spherical segments on the other side of the lens. This combination is not found in Large, even in spite of the presence of wedge shaped recesses present on one side of the lens. Again, the other side of the lens 10 of Large does not have the claimed spherical and non-spherical segments. Therefore, Large cannot be said to establish a *prima facie* case of anticipation against claim 1 in its amended form.

Lacking a basis to reject claim 1, as amended, under 35 U.S.C. § 102(b), the Examiner can only rely on 35 U.S.C. § 103(a) to allege that claim 1 is obvious. However, in order to take such a position, the Examiner must have some reason to modify Large so as to arrive at the invention. This modification cannot be based on the knowledge of the invention, but rather, must be objectively based. Lacking a direction from Large as to changing the configuration of the lens 10 to be like that claimed, there is no legitimate basis from which to make a rejection based on 35 U.S.C. § 103(a).

While the Examiner could say that the side of the lens opposite that containing the wedge shaped recesses could be altered to include the claimed segments, such an approach is the pure application of hindsight, which uses the invention as a teaching template. A rejection of this sort could not be sustained on appeal.

Moreover, the invention has a number of advantages that are unforeseen. That is, the combination of Fresnel segments on the one side and the wedge shaped recesses on the other side of the same lens means that the lens is extremely low-weighted and has a drastically reduced volume in comparison to the prior art.

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Thus, there is no basis to allege that Large establishes a *prima facie* case of obviousness against revised claim 1.

Since claim 1 is deemed to be patentable over Large, its dependent claims are also in condition for allowance.

Accordingly, the Examiner is requested to examine this application and pass all pending claims onto issuance.

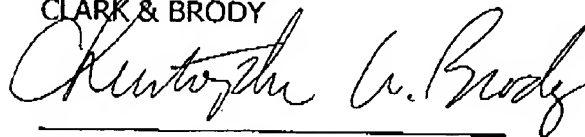
If the Examiner believes that an interview would be helpful in expediting the allowance of this application, the Examiner is requested to telephone the undersigned at 202-835-1753.

The above constitutes a complete response to all issues raised in the Office Action dated October 15, 2008.

Again, reconsideration and allowance of this application is respectfully requested.

Applicants respectfully submit that there is no fee required for this submission, however, please charge any fee deficiency or credit any overpayment to Deposit Account No. 50-1088.

Respectfully submitted,
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